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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/817,543 | 04/02/2004 | John J. McKillip | 82536 | 2532 |

22242 7590 02/21/2006

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

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| EXAMINER |
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AHMAD, NASSER

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,543

Applicant(s)

MCKILLIP, JOHN J.

Examiner

Nasser Ahmad

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on December 8, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6656555, U.S. Application Serial No. 10/395360 and U.S. Application Serial No. 10/817459 have been reviewed and are accepted. The terminal disclaimer has been recorded.

Rejection Withdrawn

2. Claims 1-20 rejected under 35 U.S.C. 112, second paragraph, made in the last Office Action of October 4, 2005 has been withdrawn in view of the amendment filed on December 8, 2005.

Allowable Subject Matter Withdrawn

3. The claims 1-20 indicated as being allowable in the last Office action has been withdrawn in view of the newly discovered prior art of Casagrande (6322655) as applied hereinbelow.

Response to Arguments

4. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-6, 11 and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Casagrande (6322655).

Casagrande relates to a business form (21) having a removable integrated card or label (47), and a method of making the same. The business form structure comprises a base layer (33), a liner layer (37) with adhesive (35) on its upper surface securing the liner to the base layer and a backing layer (43) adhesively (41) adhered to the liner layer. The liner is a transparent film (col. 9, line 9). As shown in figure-2, the structure is cut peripherally to form a card laminate with the die-cut (45) extending through the base layer and the liner layer. The carrier has printed information on both the major surfaces (abstract and col. 15, lines 46-47). The cut shape is rectangular (col. 11, lines 1-4). The die-cut can be perforations (col. 9, lines 36-37) which would include the presence of bridges. Further, figure-8 shows the presence of an integrated tab (150) comprising a portion of the base layer and being coextensive with the integrated portion. The tab is defined by a periphery of a second die-cut (146) that extend substantially through the base layer, so that the liner at least partially maintains the tab against unintentional removal from the form. Casagrande also teaches a method of making comprising providing a base layer, adhesively securing a liner layer to the base layer, forming a card by plurality of spaced die-cuts or perforations through the base and the liner layers, and making a second die-cut to form the integrated removable tab coextensive with the integrated portion.

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The base would have a greater affinity for retaining the adhesive (130) than the liner layer because of the presence of the release layer (134) in-between.

The form is provided with a plurality of portions (34, 150).

The intended use phrases such as "removable", "for retaining", "when the tab is at least partially removed", etc. have not been given any patentable weight because said phrases are not found to be of positive limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 7- 10 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande in view of Fischer (5736212).

Casagrande, as discussed above, fails to teach that there is a cut-out which is located adjacent to the periphery of the die-cut. Fischer discloses a business form (1) with integrated card (3) and a semi-arcuate cut-out (8) located adjacent to the die-cut perimeter and extending through the layers as shown in figure-13 (col. 6, lines 36-41).

Therefore, it would have been obvious to one having ordinary skill in the art to utilize Fischer's teaching of providing a cut-out adjacent to the periphery of the die-cut integrated card in the invention of Casagrande with the motivation to assist in removing from the business form.

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Further, Fischer teaches that the liner layer can have prints on the side facing the base layer (col. 3, lines 22-27).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande.

Casagrande, as discussed above, fails to teach presence of a plurality of tabs with the integrated portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Casagrande by providing a plurality of tabs with the integrated portions for additional information display, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper co. v. Bemis Co.*, 193 USPQ 8.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 2/15/06
Primary Examiner
Art Unit 1772

N. Ahmad.
February 15, 2006.